

Claim Amendments

Applicants herein cancel claims 8, 9, 12-14, 17, 21, 44 and 45 without prejudice to filing a continuation application to pursue the rejected claims. Applicants have canceled the claims solely to obtain early issue of the allowed and allowable claims. Applicants herein amend claims 34, 37, 56 and 57 to place them in condition for allowance. Applicants submit that the corresponding dependent claims, claims 35, 36, 38-42, 46-51 and 58-59, are therefore also in condition for allowance. Applicants have amended the claims by incorporating limitations from allowed claims. The claim amendments introduce no new matter.

Priority

Applicants acknowledge that this application does not claim priority to any other application. Applicants have filed a Request for Corrected Filing Receipt on 01 August 2002 to reflect that this application claims priority to no other application. This application was filed without a priority claim, but due to error on the part of the PTO a priority claim appeared on the initial filing receipt and an erroneous request by Applicants to perfect priority was made. That erroneous request is withdrawn. A corrected filing receipt indicating no claim for priority was issued on 20 August 2002.

Rejections Under 35 USC § 112, Second Paragraph

The Examiner rejected claims 8, 9, 12-14, 17, 21, 44 and 45 under 35 USC § 112, second paragraph, as being indefinite. The Examiner asserted that the term “molecular weight” or “average molecular weight” was unclear when unqualified as to the type of molecular weight, asserting that number average and weight average molecular weight can be different. Applicants thank the Examiner for clarifying his rejections under 35 USC § 112, second paragraph.

Although Applicants have canceled the rejected claims, rendering the rejections moot, Applicants respectfully disagree with the Examiner’s rejection of the challenged claims as indefinite for not specifying type of molecular weight. Applicants write to clarify the record with respect to a misunderstanding regarding the use of the term “molecular weight.” Applicants submit that the term “oligomer” as defined in the specification “means a curable compound with

one or more polymerizable unsaturated moieties and a molecular weight of greater than or equal to 1000" (page 11 lines 10-13). Thus the term oligomer, as used herein, does not refer to a compound that is necessarily synthesized as the result of a polymerization reaction that yields a population of compounds that may be polydisperse as to molecular weight. Further, Applicants submit that the meaning of "molecular weight" is well known to those of ordinary skill in the art. In support of Applicants' contentions that the term "molecular weight" in association with oligomers is well understood by those of ordinary skill in a variety of arts, Applicants refer the Examiner to the following issued US Patents that employ the term "molecular weight" in claims describing "oligomers": claims directed to oligomer resins (US 6,447,979), methacrylate copolymers of molecular weight at least 200,000 (US 6,472,065), polyester oligomers (US 6,458,468), oligomers of polyester and polyurethane of molecular weights from 250 to 10,000 (US 6,417,243), acrylate polymers of molecular weight 150 to 600 (US 6,420,003), and the like. Applicants submit that a boolean search of the USPTO's searchable patent database for the years 1996 to 2002 for "molecular weight" and "oligomer" in the claims will yield a great many more issued patents employing the term "molecular weight" and lacking the terms "number average" or "weight average."

Rejections Under 35 USC § 102(b) and 102(e)

The Examiner rejected claims 34-47, 51 and 56-59 under 35 USC § 102(e) as anticipated by, or under 35 USC § 103(a) as obvious over, Jensen et al.; the Examiner also rejected the claims under the same grounds over Oxman et al.

The Examiner rejected claims 34-42, 44-51 and 56-59 under 35 USC 102(b) as anticipated by, or under 35 USC § 103(a) as obvious over, Hubbel et al. (WO 93/17669).

Applicants have canceled all rejected claims, thereby rendering the Examiner's rejections moot. However, Applicants submit these arguments to clarify the record.

To establish a prima facie case of anticipation under 35 USC § 102(b), a single reference must disclose each and every element of the claimed invention, arranged as in the claim.

Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452 (Fed. Cir. 1984).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not be based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Jensen et al. (US 6,086,370)

The Examiner asserted that Jensen discloses polymerization strength reducers, tissue adherence accentuators, light attenuating pigments such as titanium and silicon dioxides, photoinitiators such as camphorquinone, curing assistants such as dimethyl toluidine, oligomers with low concentrations of unsaturated groups, and noted that Jensen is an adhesive that is intended to reduce the amount of heat. The Examiner concluded that claimed peak exotherm appears to be inherently the same as disclosed in Jensen et al.

Although Applicants have canceled the rejected claims, thereby rendering the rejections moot, Applicants respectfully disagree with the Examiner's rejections based on Jensen et al. Applicants submit that the Examiner has not set forth a prima facie case of anticipation or obviousness based on Jensen et al. Applicants submit that the Examiner has not shown where, in Jensen et al., each and every element of the claimed invention is presented, arranged as in the claims. Applicants submit that the Examiner has not set forth a prima facie case of obviousness based on Jensen et al. Applicants submit that the Examiner has not shown where, in Jensen et al., or in any other reference, a suggestion exists to arrive at the current invention through Jensen et al. alone or in combination with any other reference. Further, Applicants submit that Jensen et al. does not contain each and every claim limitation, and Applicants submit that no evidence was

presented as to a reasonable expectation of success of arriving at the present invention in the references cited.

Oxman et al. (US 6,187,836)

The Examiner asserted that Oxman et al. discloses a photopolymerizable composition that is capable of proceeding at less than 40 degrees Centigrade and thus appears to inherently possess the claimed peak exotherm.

Although Applicants have canceled the rejected claims, thereby rendering the rejections moot, Applicants respectfully disagree with the Examiner's rejections based on Oxman et al. Applicants submit that the Examiner has not set forth a prima facie case of anticipation or obviousness based on Oxman et al. Applicants submit that the Examiner has not shown where, in Oxman et al., each and every element of the claimed invention is presented, arranged as in the claims. Applicants submit that the Examiner has not set forth a prima facie case of obviousness based on Oxman et al. Applicants submit that the Examiner has not shown where, in Oxman et al., or in any other reference, a suggestion exists to arrive at the current invention through Oxman et al. alone or in combination with any other reference. Further, Applicants submit that Oxman et al. does not contain each and every claim limitation, and Applicants submit that no evidence was presented as to a reasonable expectation of success of arriving at the present invention in the references cited.

Hubbel et al. (WO 93/17669)

The Examiner asserted that Hubbel et al. discloses an adhesive having a macromer with a molecular weight of up to 20,000 and two acrylate groups, and that Hubbel et al. discloses monomers polymerized by addition of an initiator that embraces the claimed curing agent. The Examiner concluded that Hubbel et al. and the present invention disclose an oligomer having an unsaturation index of greater than 500 which is cured, and that the claimed peak exotherm appears to be inherent in the Hubbel et al. disclosure.

Although Applicants have canceled the rejected claims, thereby rendering the rejections moot, Applicants respectfully disagree with the Examiner's rejections based on Hubbel et al. Applicants submit that the Examiner has not set forth a prima facie case of anticipation or obviousness based on Hubbel et al. Applicants submit that the Examiner has not shown where, in Hubbel et al., each and every element of the claimed invention is presented, arranged as in the claims. Applicants submit that the Examiner has not set forth a prima facie case of obviousness based on Hubbel et al. Applicants submit that the Examiner has not shown where, in Hubbel et al., or in any other reference, a suggestion exists to arrive at the current invention through Hubbel et al. alone or in combination with any other reference. Further, Applicants submit that Hubbel et al. does not contain each and every claim limitation, and Applicants submit that no evidence was presented as to a reasonable expectation of success of arriving at the present invention in the references cited.

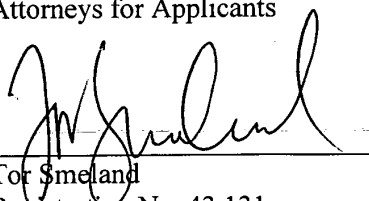
Conclusion

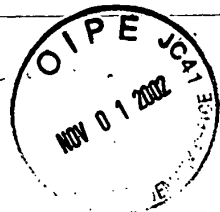
Applicants respectfully submit that this application is in condition for allowance. If there are any questions or comments relating to the present application, the Examiner is respectfully invited to contact Applicants' attorney at the telephone number below. No fee other than the fee for the three-month extension of time is believed to be necessary. If any additional fee is required, or overpayment has been made, please charge or credit our Deposit Account No. 11-0171 for such sum.

Respectfully submitted,

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Montgomery et al. Examiner: Mullis, Jeffrey C.
Filing Date: 21 April 2000 Group Art Unit: 1711
Serial No.: 09/552,994
Docket No.: 13045

For: Low Peak Exotherm Compositions

Kalow & Springut LLP
488 Madison Avenue – 19th Floor
New York, New York 10022

01 November 2002

Commissioner for Patents
Washington, DC 20231

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MARKUP OF AMENDED CLAIMS

Please amend the above-identified application as follows:

IN THE CLAIMS:

Amend the claims to include the following:

34. (Amended) A method for forming a flexible bioadhesive on a tissue, comprising:
contacting the tissue with a composition comprising [a curable unsaturated compound:] a
compound having an unsaturation index of at least about 500, a curing agent and an adhesion
promoter, wherein the composition is curable and has a peak exotherm of less than about 50°C
(120°F), and
curing the composition to form the flexible bioadhesive on the tissue.

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No. EV 035747323 US in an envelope addressed to: Commissioner for Patents, Washington
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NOV. 1, 2002
01 November 2002

Evan McHale
Evan McHale

37. (Amended) A composition comprising:
a [curable unsaturated] compound having an unsaturation index of at least about 500, and
a curing agent, wherein the composition is curable and has a peak exotherm of less than
about 50°C (120°F).

56. (Amended) A composition comprising [a curable unsaturated compound] a compound
having less than about 40 % monomers, an unsaturation index of at least about 500, a curing
agent and an adhesion promoter, wherein the composition is curable and has a peak exotherm of
less than about 50°C (120°F).

57. (Amended) A method of making a composition comprising the steps of:
selecting a [curable unsaturated] compound having an unsaturation index of at least 500;
and
mixing said [curable unsaturated] compound with a curing agent and an adhesion
promoter, wherein the mixture is curable and has a peak exotherm of less than about 50°C
(120°F).

Respectfully submitted,

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